REMARKS

Claims 1 and 3-10 stand rejected upon informalities. Claims 1, 3-12, and 14-17, all the claims pending in the application, further stand rejected on prior art grounds. Applicants respectfully traverse these rejections based on the following discussion.

I. The 35 U.S.C. §112, Second Paragraph, Rejection

[0001] Claims 1 and 3-10 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action provides "The new limitation added to independent claims 1 and 10 recites "providing resource usage information ... , said providing comprising allocating". The newly added "said providing comprising allocating" does not make grammatical sense and makes the claim unclear. In a method step starting with term "providing", "providing" needs to be followed by a noun (i. e. information). Providing allocating is unclear. Claim 9 uses means plus function language. The new limitations make it unclear which structure applies to the "means for providing"." The Applicants respectfully disagree because, as claimed, the process of "providing resource usage information …" comprises the process of "allocating overlapping usage of the computer resources…". However, in order to clarify this limitation and to overcome the rejection, the language in independent claims 1, 9 and 10 has been amended to claim "determining resource usage information" (as opposed to simply providing it), wherein the process of determining such resource usage information comprises a process of "allocating overlapping usage of the computer resources …".

[0002] In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this rejection.

II. The Prior Art Rejections

[0003] Claims 1, 3-12, and 14-17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Halliday, et al. (U.S. Publication No. 2002/0083003), hereinafter referred to as Halliday, in view of Birkestrand, et al. (U.S. Publication No. 2005/0044228, filed on August 21, 2003 and published on February 24, 2005), hereinafter referred to as Birkestrand. Applicants respectfully traverse these rejections, submitting that Birkestrand should be disqualified as prior art against the claimed invention pursuant to 35 U.S.C. §103(c), as discussed in MPEP§2146.

[0004] Specifically, 35 U.S.C. §103(c), (1) provides that "Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person." Birkestrand only qualifies as prior art under subsection (e) of 35 U.S.C. §102. Furthermore, both the invention of Birkestrand and the present invention were, at the time the claimed invention was made, subject to an obligation of assignment to the same person, namely International Business Machines Corporation (IBM), Armonk, NY, as evidenced by ATTACHMENT A, a copy of the Notice Of Recordation Of Assignment of the present application to (IBM) , and as further evidenced by ATTACHMENT B, a copy of the first page of the published application of Birkestrand indicating assignment to IBM. Therefore, Birkestrand should be disqualified from being cited as

prior art against the present application under 35 U.S.C. §103(c).

[0005] More specifically, the cited prior art reference, Birkestrand, is an application for patent, published under section 122(b), by another filed in the United States before the invention by the Applicants of the present application and, thus, qualifies as prior art under 35 U.S.C. §102(e). However, Birkestrand does not qualify as prior art under any of the other subsections of 35 U.S.C. §102. For example, Birkestrand does not qualify as prior art under subsection (a) of 35 U.S.C. §102 because it was not known or used by others in this country, nor was it patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent. That is, because Birkestrand has yet to be patented and because the December 5, 2003 filing date of the present application is before the February 24, 2005 publication date of Birkestrand, Birkestrand does not qualify as prior art under 35 U.S.C. §102(a). Birkestrand also does not qualify as prior art under (b) of 35 U.S.C. §102 because Birkestrand was not patented, nor was it described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the filing date of the present application. That is, since Birkestrand has yet to be patented and since it was not published until after the present application was filed, Birkestrand does not qualify as prior art under 35 U.S.C. §102(b). 35 U.S.C. §102 subsections (c) and (d) do not apply as they are not prior art based bars to patentability. Therefore, since Birkestrand would only qualify as prior art under 35 U.S.C. §102(e) and since at the time the claimed invention in the present application was made, Birkestrand and the claimed invention were subject to an obligation of assignment to IBM (see ATTACHMENTS A AND B), the Applicants respectfully request that Birkestrand be disqualified as a prior art reference against the claimed invention under 35 U.S.C. §103(c).

[0006] The Office Action acknowledged that Halliday does not disclose all of the limitations of all the claims of the present invention and, therefore, cited Birkestrand. Consequently, in light of the disqualification of Birkestrand, the Applicants submit that claims 1, 3-12, and 14-17 are in condition for allowance. That is, in rejecting independent claims 1, 9, 10, and 11 the Office Action acknowledged that Halliday does not disclose the allocating limitation. Therefore, independent claims 1, 9, 10 and 11 are patentable over Halliday. Further, dependent claims 3-8, 12, and 14-17 are similarly patentable, not only by virtue of their dependency from a patentable independent claim, but also by virtue of the additional features of the invention they define. Moreover, the Applicants note that all claims are properly supported in the specification and accompanying drawings, and no new matter is being added. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections.

III. Formal Matters and Conclusion

With respect to the rejections to the claims, the claims have been amended, above, to overcome these rejections. In view of the foregoing, Applicants submit that claims 1, 3-12, and 14-17, all the claims presently pending in the application, are patentably distinct from the prior art of record and are in condition for allowance. Therefore, the Examiner is respectfully requested to reconsider and withdraw the rejections to the claims and further to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to

discuss any other changes deemed necessary. Please charge any deficiencies and credit any overpayments to Attorney's Deposit Account Number 09-0441.

Respectfully submitted,

Dated: January 5, 2009

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ATTACHMENT A

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

JUNE 30, 2004

102626059A

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ASSIGNOR:
AGARWAL, VIKAS
DOC DATE: 11/16/2003

ASSIGNOR:
KARNHIK NEERAN M.
DOC DATE: 11/14/2003

ASSIGNOR:
KUMAR, ARUN
DOC DATE: 11/14/2003

ASSIGNEE:
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SERIAL NUMBER: 10729803
PATENT NUMBER:
TITLE: RESOURCE USAGE METERING OF NETWORK SERVICES

FILING DATE: 12/05/2003
ISSUE DATE:

DIANE RUSSELE, PARALEGAL
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

ATTACHMENT B

US 20050044228A1

(19) United States

(12) Patent Application Publication (10) Pub. No.: US 2005/0044228 A1

Birkestrand et al. (43) Pub. Date: Feb. 24, 2005

(54) METHODS, SYSTEMS, AND MEDIA TO EXPAND RESOURCES AVAILABLE TO A LOGICAL PARTITION

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(52) **U.S. Cl.** **709/226**; 709/213

(57) **ABSTRACT**

Methods, systems, and media to expand resources available to logical partition associated with a client are contemplated. Embodiments may associate the logical partition with a grid that retains a list of resources, referred to as grid resources, available for allocation to logical partitions. The grid resources may include resources from, e.g., other logical partitions within the logically partitioned system, logical partitions from other logically partitioned systems, another type of system, a cluster, and the like. Further, one or more of the systems associated with the grid may include on-demand resources that are also available to supplement resources based upon the demands of the client. Embodiments may also monitor resource usage by the client and meter billable usage of the grid resources and/or on-demand resources based upon agreements between service providers and clients.